

Serial No.: 10/769,933  
Attorney Docket No.: NEW10-GN005 (39824)  
Amendment

## **REMARKS**

### **I. Introductory Comments**

Claims 1-3, 5-12, 14-16, and 18-23 and 25-28 are currently pending in the application. Claims 13 and 24 have been canceled. Claims 1, 14, and 25 have been amended. Support for the amendments can be found in the specification, drawings and claims of the application as filed. Reconsideration of the Application is respectfully requested.

### **II. Rejections under 35 U.S.C. § 112**

Claims 1-3, 5-16, 18-28 have been rejected as incorporating new matter, in particular that the limitation "the cross-sectional area at least equal to the cross-sectional area of any other section of the container" is not supported by the drawings, specification and claims of the application as filed. While applicant respectfully traverses the Office's position in that the drawings clearly depict a container meeting that limitation, claims incorporating that limitation have been amended to remove it. Therefore, it is believed that the 35 U.S.C. § 112 rejections have been overcome.

### **III. Rejections under 35 U.S.C. § 103**

The Office contends that claims 1-3, 5-16 and 18-28 are rendered obvious in view U.S. Pat. No. 5,213,431 to Gentile et al. in light of U.S. Pat. No. 4,150,904 to Stewart. In light of the amendments to the claims herein, the rejection on this basis is respectfully traversed.

In particular, it is noted that all of the claims now explicitly require that the valve be positioned above the cylindrical paint application element at a point "such that the longitudinal centerline of the valve is positioned offset and above the centerline of the paint application element when the paint applicator is placed in an inverted use position." This limitation is in stark contrast to the teachings of both Gentile and Stewart disclosing the valve having a longitudinal centerline that is not offset from the centerline of the paint

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application element. In stark contrast, both Gentile and Stewart teach valves that are directly, radially in-line with the centerline of the cylindrical application element. Further, both Gentile and Stewart teach a valve that is positioned directly on the centerline, not above it, when the applicator is placed in the inverted, use position.

This limitation is important in that the offset positioning of the valve as disclosed and claimed in the present application makes it much less likely that the paint in the storage container and valve body will drip onto the paint application element undesirably, thereby causing a mess and interfering with the desired painting result. See, e.g. Para 025, "aperture of valve assembly 52 is provided above the central axis of paint roller cover 16 in order to facilitate paint application through aperture 56 without a mess." It is clear that neither the Gentile or Stewart references teaches, discloses or suggests this limitation, much less the importance thereof in preventing undesirable dripping of the valve onto the applicator device. For this reason, all of the claims as amended are patentable over the cited references and early indication thereof is respectfully requested.

With respect to claims 3 and 16 it is further submitted that neither Gentile nor Stewart teaches a living hinge for hinging a cap to the paint applicator. The Office cites elements 62 and 64 of the Gentile reference as comprising the "living hinge" element recited in applicants' claims 3 and 16. However, it is clear by reviewing the specification and drawings of the Gentile reference that elements 62 and 64 are snaps or detents and cannot be considered a hinge of any sort, much less a living hinge. The applicant's are unaware of any technical definition of "hinge" that would encompass the snaps or detents as disclosed in Gentile. As such, on this basis as well, claims 3 and 16 are allowable over the cited prior art.

#### IV. Conclusion

In light of the foregoing, it is respectfully submitted that the pending claims, as amended, are enabled, sufficiently described, novel, and non-obvious, and thus are in

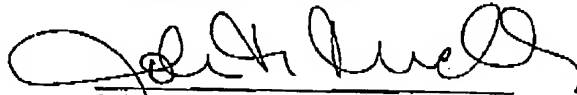
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condition for allowance. Reconsideration and withdrawal of the rejections of record is respectfully requested.

The Commissioner for Patents is hereby authorized to charge any additional fees that may be required by this paper, or to credit any overpayment to Deposit Account 50-3072.

If the Examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number provided below.

Respectfully submitted,



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